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**UTILITY
PATENT APPLICATION
TRANSMITTAL**

for new nonprovisional applications under 37 CFR 1.53(b))

Attorney Docket No.

7791-0092-25X DIV

First Inventor or Application Identifier

Will H. GARDENSWARTZ

Title

COMMUNICATING WITH A COMPUTER BASED ON THE OFFLINE
PURCHASE HISTORY OF A...**APPLICATION ELEMENTS**

See MPEP chapter 600 concerning utility patent application contents

ADDRESS TO:

Assistant Commissioner for Patents
Box Patent Application
Washington, DC 20231

1. ☒ Fee Transmittal Form (e.g. PTO/SB/17)
(Submit an original and a duplicate for fee processing)

2. ☒ Specification Total Pages **53**

3. ☒ Drawing(s) (35 U.S.C. 113) Total Sheets **11**

4. ☒ Oath or Declaration Total Pages **9**

a. ☐ Newly executed (original or copy)

b. ☒ Copy from a prior application (37 C.F.R. §1.63(d))
(for continuation/divisional with box 15 completed)

- i. ☐ **DELETION OF INVENTOR(S)**
Signed statement attached deleting inventor(s) named
in the prior application, see 37 C.F.R. §1.63(d)(2) and
1.33(b).

5. ☒ Incorporation By Reference (usable if box 4B is checked)
The entire disclosure of the prior application, from which a copy of the
oath or declaration is supplied under Box 4B, is considered to be part
of the disclosure of the accompanying application and is hereby
incorporated by reference therein.

ACCOMPANYING APPLICATION PARTS

6. ☒ Assignment recorded at Reel/Frame 9971/0240
7. ☐ 37 C.F.R. §3.73(b) Statement (when there is an assignee) ☐ Power of Attorney
8. ☐ English Translation Document (if applicable)
9. ☒ Information Disclosure Statement (IDS)/PTO-1449 & ☐ Copies of IDS Citations 892
10. ☒ Preliminary Amendment
11. ☐ White Advance Serial No. Postcard
12. ☐ Small Entity Statement(s) ☐ Statement filed in prior application. Status still proper and desired.
13. ☐ Certified Copy of Priority Document(s) (if foreign priority is claimed)
14. ☒ Other: Request for Priority; Petition to Make Special

15. If a CONTINUING APPLICATION, check appropriate box, and supply the requisite information below:

☐ Continuation ☒ Divisional ☐ Continuation-in-part (CIP) of prior application no.: 09/226,174

Prior application information: Examiner: Vu

Group Art Unit: 2758


16. Amend the specification by inserting before the first line the sentence:

☒ This application is a ☐ Continuation ☒ Division ☐ Continuation-in-part (CIP)
of application Serial No. 09/226,174 Filed on January 7, 1999

☒ This application claims priority of provisional application Serial No. 60/114,462 Filed December 30, 1998.

17. CORRESPONDENCE ADDRESS

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Name:	Robert C. Mattson	Registration No.:	42,850

Docket No. 7791-0092-25X DIV

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

INVENTOR(S) Will H. GARDENSWARTZ et al

SERIAL NO: New Application

FILING DATE: Herewith

FOR: COMMUNICATING WITH A COMPUTER BASED ON THE OFFLINE PURCHASE HISTORY OF A...

JCL35 U.S. PRO
09/472197
12/27/99

FEE TRANSMITTAL

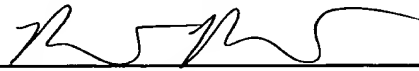
ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

FOR	NUMBER FILED	NUMBER EXTRA	RATE	CALCULATIONS
TOTAL CLAIMS	6 - 20 =	0	× \$18 =	\$0.00
INDEPENDENT CLAIMS	3 - 3 =	0	× \$78 =	\$0.00
<input type="checkbox"/> MULTIPLE DEPENDENT CLAIMS (If applicable)			+ \$260 =	\$0.00
<input type="checkbox"/> LATE FILING OF DECLARATION			+ \$130 =	\$0.00
BASIC FEE				\$760.00
TOTAL OF ABOVE CALCULATIONS				\$760.00
<input type="checkbox"/> REDUCTION BY 50% FOR FILING BY SMALL ENTITY				\$0.00
<input type="checkbox"/> FILING IN NON-ENGLISH LANGUAGE			+ \$130 =	\$0.00
<input type="checkbox"/> RECORDATION OF ASSIGNMENT			+ \$40 =	\$0.00
TOTAL				\$760.00

- ☐ Please charge Deposit Account No. 15-0030 in the amount of _____ A duplicate copy of this sheet is enclosed.
- ☒ A check in the amount of \$890.00 - to cover the filing fee is enclosed.
- ☒ The Commissioner is hereby authorized to charge any additional fees which may be required for the papers being filed herewith and for which no check is enclosed herewith, or credit any overpayment to Deposit Account No. 15-0030. A duplicate copy of this sheet is enclosed.

Respectfully Submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



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(OSMMN 11/98)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: WILL H. GARDENSWARTZ ET AL

GAU:

SERIAL NO: NEW APPLICATION

EXAMINER:

FILED: HEREWITH

FOR: COMMUNICATING WITH A COMPUTER BASED ON THE OFFLINE PURCHASE HISTORY OF A PARTICULAR CONSUMER



REQUEST FOR PRIORITY

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

SIR:

- ☒ Full benefit of the filing date of U.S. Application Serial Number 09/226,174, filed January 7, 1999, is claimed pursuant to the provisions of 35 U.S.C. §120.
- ☒ Full benefit of the filing date of U.S. Provisional Application Serial Number 60/114,462, filed December 30, 1998, is claimed pursuant to the provisions of 35 U.S.C. §119(e).
- ☐ Applicants claim any right to priority from any earlier filed applications to which they may be entitled pursuant to the provisions of 35 U.S.C. §119, as noted below.

In the matter of the above-identified application for patent, notice is hereby given that the applicants claim as priority:

<u>COUNTRY</u>	<u>APPLICATION NUMBER</u>	<u>MONTH/DAY/YEAR</u>
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Certified copies of the corresponding Convention Application(s)

- ☐ are submitted herewith
- ☐ will be submitted prior to payment of the Final Fee
- ☐ were filed in prior application Serial No. filed
- ☐ were submitted to the International Bureau in PCT Application Number .
Receipt of the certified copies by the International Bureau in a timely manner under PCT Rule 17.1(a) has been acknowledged as evidenced by the attached PCT/IB/304.
- ☐ (A) Application Serial No.(s) were filed in prior application Serial No. filed ; and
(B) Application Serial No.(s)
 - ☐ are submitted herewith
 - ☐ will be submitted prior to payment of the Final Fee

Respectfully Submitted,

OBLON, SPIVAK, McCLELLAND,
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RAN:RCM:djn

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7791-0092-25X DIV

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
WILL H. GARDENSWARTZ, ET AL. : GROUP:
SERIAL NO.: NEW APPLICATION : EXAMINER:
FILED: HEREWITH :
FOR: COMMUNICATING WITH A :
COMPUTER BASED ON THE :
OFFLINE PURCHASE HISTORY :
OF A PARTICULAR CONSUMER :



Received
MAR 01 2000
Director's Office
Group 2700

PETITION TO MAKE SPECIAL UNDER M.P.E.P. § 708.02(VIII)

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

SIR:

I. Basis For the Petition

Pursuant to MPEP § 708.02(VIII) (7th ed.1998), applicants hereby petition for a special status for this application.

II. Requirements for Granting Special Status

MPEP § 708.02(VIII) provides five requirements for a grant of special status. The following subsections show that each of these five requirements is met.

A. Submit Petition and Fee: § 708.02(VIII)(A)

This petition is accompanied by the fee set forth in 37 CFR § 1.17(i).

B. Agree to an Election Without Traverse: § 708.02(VIII)(B)

Applicants submit that all claims not canceled by the preliminary amendment submitted herewith are directed to a single, patentable invention because each of these claims was identified as being drawn to a single invention in the Office Action of November 23,

1999, in the parent (Ser. No. 09/226,174) of the present application. However, should the Office determine that all the claims presented are not directed to a single invention, applicants agree to elect the largest group of claims that includes claim 85.

**C. State that a Pre-examination Search Was Made:
§ 708.02(VIII)(C)**

The claims in the present application define substantially the same subject matter as claims presented in parent application Ser. No. 09/226,174. Therefore, the searches performed for the parent application are applicable to the present application.

A preexamination search was made in the parent application. The pre-examination search included a search of the following classes and subclasses: (1) class 705, subclasses 10, 14, 16, 17, 22, and 23; and (2) class 235, subclasses 375 and 383. Examiner Edward R. Cosimano of Art Unit 2761 was consulted in developing the field of search. Also, a key word search was performed on the U.S. Patent Office Automated Patent System computer database. Forward citation searches were also performed for the more relevant patents found during the course of the search as well as a review of the patents cited on the more relevant patents.

Further, an International Search Report was received for International Application No. PCT/US 99/03272, which claims priority to the parent application.

**D. Submit a Copy of the Most Relevant References:
§ 708.02(VIII)(D)**

Since the present application is a division of application Ser. No. 09/226,174, all of the references considered in the parent application are deemed to be of record in the present application. Accordingly, the references deemed most relevant to the present claims are of record and are not resubmitted.

E. Submit a Detailed Discussion of the References, Pointing Out How the Claimed Subject Matter is Patentable Over the References: § 708.02(VIII)(E)

Each of the independent claims includes features not taught or suggested by the references deemed most relevant to the claims. The patentable features of each independent claim are discussed below followed by an analysis of the references deemed most relevant to the claims.

Claim 85 is directed to a memory including a field for storing a first identifier corresponding to a first computer associated with a consumer and a field for storing a second identifier associated with the first identifier. The second identifier corresponds to an observed offline purchase history of the consumer. The purchase history includes information of an offline purchase of the consumer collected at a point of sale when the offline purchase transpired. None of the references discussed below teach or suggest linking a first identifier corresponding to a computer with a second identifier corresponding to an observed offline purchase history including information of an offline purchase of a consumer collected at a point of sale when the offline purchase transpired. Thus, claim 85 is believed to patentably distinguish over the references below.

Claim 87 is directed to a memory that includes a field for storing a first identifier corresponding to a first computer and associated with an observed offline purchase history of a consumer. The memory also includes a field for storing a purchase behavior classification based on at least one selected purchase behavior criterion and the observed offline purchase history of the consumer. The purchase history includes information of an offline purchase of the consumer collected at a point of sale when the offline purchase transpired. The references below neither teach nor suggest a memory that links a first computer, an observed offline purchase history of a consumer, and a purchase behavior classification based on at

selected purchase behavior criterion and the observed offline purchase history of the consumer. Accordingly, claim 87 is believed to patentably distinguish over the references below.

Claim 89 is directed to a memory that includes a field for storing a first identifier corresponding to a targeted message and a purchase behavior classification based on at least one selected purchase behavior criterion and the observed offline purchase history of the consumer. The purchase history includes information of a purchase of the consumer collected at a point of sale when the purchase transpired. The memory also includes a field for storing a personal identification number corresponding to the consumer. The references of record fail to disclose a memory that associates a targeted message, a purchase behavior classification based on at least one selected purchase behavior criterion and an observed offline purchase history, and a personal identification number corresponding to the consumer. Therefore, claim 89 is believed to patentably distinguish over the references of record.

Below, each of the references deemed most relevant to the claims is briefly discussed in light of the inventive feature believed most pertinent to the reference for purposes of this petition.

The Powell 5,806,044 patent discloses a system and method for distributing coupons through a system of computer networks. Coupons are delivered through a computer network, but there is no link between a first identifier corresponding to a computer and a second identifier corresponding to an observed offline purchase history including information of an offline purchase of a consumer collected at a point of sale when the offline purchase transpired.

The Day et al. 5,857,175 patent discloses a system and method for offering targeted discounts to customers. However, Day et al. do not disclose linking a first identifier

corresponding to a computer with a second identifier corresponding to an observed offline purchase history including information of an offline purchase of a consumer collected at a point of sale when the offline purchase transpired.

The O'Brien et al. 5,832,457 patent discloses a method and apparatus for the selective distribution of discount coupons based on prior customer behavior. However, O'Brien et al. do not link a first identifier corresponding to a computer with a second identifier corresponding to an observed offline purchase history including information of an offline purchase of a consumer collected at a point of sale when the offline purchase transpired.

The Jovicic et al. 5,855,007 patent discloses an electronic coupon communication system. However, Jovicic et al. fail to link a first identifier corresponding to a computer with a second identifier corresponding to an observed offline purchase history including information of an offline purchase of a consumer collected at a point of sale when the offline purchase transpired.

The Deaton et al. 5,201,010 patent discloses a method and system for building a database and performing marketing based upon prior shopping history. A customer database is utilized to perform targeted marketing functions, but nothing in Deaton et al. teaches or suggests linking a first identifier corresponding to a computer with a second identifier corresponding to an observed offline purchase history including information of an offline purchase of a consumer collected at a point of sale when the offline purchase transpired.

The Deaton et al. 5,237,620 patent discloses a check reader method and system for reading check MICR code. Nothing in Deaton et al. teaches or suggests linking a first identifier corresponding to a computer with a second identifier corresponding to an observed offline purchase history including information of an offline purchase of a consumer collected at a point of sale when the offline purchase transpired.

The Deaton et al. 5,687,322 patent discloses a method and system for selective incentive point-of-sale marketing in response to customer shopping histories. However, nothing in the '322 patent teaches or suggests linking a first identifier corresponding to a computer with a second identifier corresponding to an observed offline purchase history including information of an offline purchase of a consumer collected at a point of sale when the offline purchase transpired.

The Deaton et al. 5,621,812 patent discloses a method and system for building a database for use with selective incentive marketing in response to customer shopping histories. Nowhere does the '812 patent teach or suggest linking a first identifier corresponding to a computer with a second identifier corresponding to an observed offline purchase history including information of an offline purchase of a consumer collected at a point of sale when the offline purchase transpired.

The Deaton et al. 5,592,560 patent discloses a method and system for building a database and performing marketing based upon prior shopping history. The system includes a database of customer data relating to products previously purchased by the customers but does not disclose linking a first identifier corresponding to a computer with a second identifier corresponding to an observed offline purchase history including information of an offline purchase of a consumer collected at a point of sale when the offline purchase transpired.

The Deaton et al. 5,642,485 patent discloses a method and system for selective incentive point-of-sale marketing in response to customer shopping histories. However, nothing in the '485 patent teaches or suggests linking a first identifier corresponding to a computer with a second identifier corresponding to an observed offline purchase history

including information of an offline purchase of a consumer collected at a point of sale when the offline purchase transpired.

The Deaton et al. 5,644,723 patent discloses a method and system for selective incentive point-of-sale of marketing in response to customer shopping histories. The system includes a memory for storing a database of previously entered customer identification codes and transaction data. However, the '723 patent fails to disclose linking a first identifier corresponding to a computer with a second identifier corresponding to an observed offline purchase history including information of an offline purchase of a consumer collected at a point of sale when the offline purchase transpired.

The Deaton et al. 5,305,196 patent discloses a database building and marketing system in which customer identification numbers are used to deliver targeted marketing functions based on a customer database that includes information such as whether the customer is a "high volume" shopper. Targeted incentives are physically delivered to the customer at the point-of-sale or by regular mail. On the other hand, the present invention links a first identifier corresponding to a computer with a second identifier corresponding to an observed offline purchase history including information of an offline purchase of a consumer collected at a point of sale when the offline purchase transpired.

The Gerace 5,848,396 patent discloses a method and apparatus for determining the behavioral profile of a computer user. A behavioral profile is formed by recording computer activity and viewing habits of computer users. However, the behavioral profiles does not include information of the offline purchases of consumers collected when the offline purchases transpired.

The Golden et al. 5,761,648 patent discloses an interactive marketing network and a process using electronic certificates. User profiles are stored and updated but do not include information of consumers' offline purchases collected when the offline purchases transpired.

The Schultz et al. 5,056,019 patent discloses an automated purchase reward accounting system and method. However, the reference fails to teach or suggest linking a first identifier corresponding to a computer with a second identifier corresponding to an observed offline purchase history including information of an offline purchase of a consumer collected at a point of sale when the offline purchase transpired.

The De Lapa et al. 5,353,218 patent discloses a focused coupon system. Consumer and coupon identifications are encoded on coupons so that the identifications may be read at point-of-sale terminals. However, De Lapa et al. fail to disclose linking a first identifier corresponding to a computer with a second identifier corresponding to an observed offline purchase history including information of an offline purchase of a consumer collected at a point of sale when the offline purchase transpired.

The Stein et al. 5,459,306 patent discloses a method and system for delivering on demand, individually targeted promotions. Information on a user's use of a product during product use is gathered, correlated, and stored. However, Stein et al. do not incorporate a purchase history including information of offline purchases of consumers collected when the offline purchase is transpired.

WO 97/23838 discloses a system and method for delivering purchasing incentives and a variety of other retail shopping aids through a computer network. However, WO 97/23838 does not disclose linking a first identifier corresponding to a computer with a second identifier corresponding to an observed offline purchase history including information

of an offline purchase of a consumer collected at a point of sale when the offline purchase transpired.

EP 0 512 509 A2 discloses a system for automatically distributing discount coupons or certificates in retail stores, conditioned on a preselected combination of present and past shopping behavior. However, EP 0 512 509 A2 does not disclose linking a first identifier corresponding to a computer with a second identifier corresponding to an observed offline purchase history including information of an offline purchase of a consumer collected at a point of sale when the offline purchase transpired.

The Deaton et al. 5,649,114 patent discloses a method and system for selective incentive point-of-sale marketing in response to customer shopping histories. At the point-of-sale, coupons or other incentives may be generated which are specifically targeted to a specific customer based upon his prior history.¹ This is different from the present invention in which a first identifier corresponding to a computer is linked with a second identifier corresponding to an observed offline purchase history including information of an offline purchase of a consumer collected at a point of sale when the offline purchase transpired.

The Lalonde et al. 5,283,731 patent discloses a computer-based classified ad system and method. When a new advertisement is placed in an advertisement database, the new ad is compared to want ads. If a match is found, the system generates output data that includes the new ad and the delivery data for the matching want ad. However, Lalonde et al. do not teach or suggest linking a first identifier corresponding to a computer with a second identifier corresponding to an observed offline purchase history including information of an offline purchase of a consumer collected at a point of sale when the offline purchase transpired.

¹See column 7, lines 33-35.

The Goldhaber et al. 5,855,008 patent discloses a method for distributing advertising and other information over a computer network. A link between an advertisement and viewers is provided by a database of digitally stored demographic profiles of potential users. However, Goldhaber et al. neither teach nor suggest linking a first identifier corresponding to a computer with a second identifier corresponding to an observed offline purchase history including information of an offline purchase of a consumer collected at a point of sale when the offline purchase transpired.

WO 98/15907 discloses a method for organizing a discount or coupon system. However, based on the abstract and figures of WO 98/15907, there is no teaching or suggestion to link a first identifier corresponding to a computer with a second identifier corresponding to an observed offline purchase history including information of an offline purchase of a consumer collected at a point of sale when the offline purchase transpired.

WO 97/12486 discloses a multimedia architecture for interactive advertising. The multimedia programming has a varying content determined by data contained in a database for storing information about a viewer. However, there is no teaching or suggestion of linking a first identifier corresponding to a computer with a second identifier corresponding to an observed offline purchase history including information of an offline purchase of a consumer collected at a point of sale when the offline purchase transpired.

III. Conclusion

The petition to make special should be granted. Therefore, applicants respectfully request that this application be advanced out of turn for examination.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'R. Neifeld', with a long horizontal flourish extending to the right.

Richard Neifeld, Ph.D.
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Registration No. 35,299
Robert Mattson
Registration No. 42,850

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Printed: December 22, 1999 (2:57PM)
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